

REMARKS

A. § 102 (b) Rejections

The Examiner rejected claims 29, 45, 54, 55, 57 and 58 as being anticipated by Published Patent Application NZ 511,508 (published 4/26/2002) to Barker (“Barker”). Barker teaches a girth monitor wherein a cord is made of links capable of forming a close-fitting, closed loop about the waist of a person. However, Barker does not explicitly or inherently disclose a coupling member (5, in Spec.) rotatably connected to the plurality of links (3) such that the links (3) of the cord rotate relative to the cord’s position on the wearer’s body. In contrast, the present invention encompasses a plurality of links (3) that rotate along the contours of the wearer’s body. (See Spec. p. 3, ll. 12-13.) In this manner, the chain of the present invention provides a more comfortable method for monitoring and controlling an obese person’s weight. A cord made of a linked design as shown in Barker would not rotate in this manner, and thus would suffer from the inherent problem of providing sharp metal links against the wearer’s skin, which may cut or rub into the skin of the wearer when the cord is being worn continuously.

Applicants have amended independent claim 29 to include a plurality of coupling members rotatably connected to a plurality of links (previously found in claim 55, which has been cancelled), and this stipulation carries over to claims 45, 54, 54, 57 and 58, which depend on claim 29. As so amended, these claims clearly distinguish Applicants’ invention from the Barker reference. The rejection of claims 29, 45, 54, 57 and 58 under 35 U.S.C. § 102 (b) as anticipated by Barker should be withdrawn, and the Examiner is respectfully requested to do so.

B. § 103 (a) Rejections

The Examiner rejected claims 45-58 under 35 U.S.C. § 103 (a) as being unpatentable over Barker in view of U. S. Patent No. 2,671,545 to Hall ("Hall"). Specifically, the Examiner notes that Barker teaches the claimed invention excepting the type of chain used, and that Hall teaches the claimed ball chain. (*See* Office Action p. 3.)

As provided in M.P.E.P. 706.02(j), to establish a *prima facie* obviousness of rejection, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). The criteria do not apply to the rejection of claims 45-58.

First, there is nothing contained in the two references suggesting that Barker and Hall be combined. Barker specifies a light chain with a catch means such "that the loop formed around the person's waist can be opened from time to time and so that the circumference of the loop can be incrementally altered." (Barker p. 4, ll. 71-75.) Removal or occasional, incremental adjustment is accomplished link by link. (*Id.* p. 8, l. 174-75.) This occasional adjustment is to be carried out by the user as required (*id.* p. 11, ll. 254-56), utilizing incremental settings provided by using a catch capable of engaging with any links of the chain (*id.*). The ornamental chain found in Hall specifies alternate spherical and elongate beads. As noted in Hall, to shorten the ornamental chain, a cut must be made between two spherical beads to sever a coupling

member. (Hall, col. 2, ll. 1-6.) To connect the ends of the chain, a snap connector must be utilized to house spherical beads from each end. (*id.* ll. 9-16.)

Because the invention of Barker depends upon removal “link by link” by the user as his waist decreases or increases, it would be very difficult for an obese person to manage severing the connecting member and then replacing the new spherical end within a snap connector. Indeed, one advantage of using a chain with a plurality of coupling members and a plurality of links such as the one in the claimed invention is that it is difficult to tamper with by the user and is to be adjusted or removed by a healthcare professional, not the user. (*See Spec.* p. 5, ll. 3-5.) Thus, it would not be obvious to use the beaded chain of Hall in the Barker invention. A permanent end link as described in one embodiment of the present invention is necessarily removed as the chain is shortened by such a professional, and replaced on the new end of the shorter chain. The invention of Barker contemplates that the end “catch” is fixed and the opposing end of the chain of links is simply shortened by removal of links. The ornamental chain of Hall would not suit this purpose. There is no suggestion in either reference that a beaded chain would be desirable in the system taught by Barker.

Further, the links shown in figures by Barker would not be rotatable along the contours of the wearer’s body. (*See Figs. 2, 3.*) These links, of a conventional type as shown, indicate a two dimensional nature wherein the link, as joined to the adjacent links, does not present the same surface profile to the user at all times (as a spherical or cylindrical link found in a beaded chain would). As such, any movement of the cord along the contours of the user’s body will result in cutting, abrasion, or general discomfort to the user. It would not have been obvious to one skilled in the art to provide a beaded chain to solve this problem, as is evidenced by the fact that prior art devices typically consisted of nylon filaments or cords, not beaded chains. (*See*

Declarations of Drs. Greenway, Fujioka, filed with 09/09/05 response to 03/09/05 Office Action). Moreover, the invention in Barker is preferably “specifically made to be attractive” (*id.* p. 4, l. 68) or “decorative” (*id.* p. 5, l. 97). Although the beaded chain of the present invention may be aesthetically preferable to a nylon cord, there is no suggestion in Barker to combine its teachings with the beaded chain of Hall, which is functional in appearance.

Additionally, there is no reasonable expectation of success in using a beaded chain like that of Hall with the invention shown in Barker. The decorative nature and ease of use by the wearer found in the Barker girth monitor would not indicate that its implementation with a beaded chain could be expected to succeed. Finally, without hindsight using the Applicant’s disclosure, a girth monitoring device comprising a linked chain with removable conventional links as shown in Barker would not suggest or motivate one skilled in the art to use the beaded chain of Hall to accomplish the same result. Necessarily, the decorative and easy to use features of the Barker girth monitor would not necessarily have been retained by substituting the beaded chain of Hall for a conventionally linked chain.

In light of these remarks and amendments, Applicant respectfully submits that the above amended claims are now in condition for allowance and respectfully requests allowance of the same case. The undersigned asks that the examiner contact her at (225) 248-2124 if he has any questions so that allowance might be reached.

RESPECTFULLY SUBMITTED:

Date: July 5, 2006



AMELIA K. SMITH
Registration No.: 58,198
Jones, Walker, Waechter, Poitevent,
Carrère & Denègre, L.L.P.
8555 United Plaza Boulevard, 4th Floor
Baton Rouge, LA 70809
Telephone: (225) 248-2124
Facsimile: (225) 248-3124